



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,080	10/12/2004	Andreas Ruther	PAT-00356/BC1-0166	7054
77224	7590	11/27/2009	EXAMINER	
Mary E. Golota Cantor Colburn LLP 201 W. Big Beaver Road Suite 1101 Troy, MI 48084			LIGHTFOOT, ELENA TSOY	
			ART UNIT	PAPER NUMBER
			1792	
			NOTIFICATION DATE	DELIVERY MODE
			11/27/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

MARJORIE.ELLIS@BASF.COM  
Mgolota@CantorColburn.com  
usptopatmail@cantorcolburn.com

***Advisory Action***

The Request for Reconsideration filed on November 17, 2009 under 37 CFR 1.116 in reply to the final rejection has been entered and considered but is not deemed to place the application in condition for allowance for the reasons of record set forth in the Final Office Action mailed on May 18, 2009.

***Response to Arguments***

Applicant's arguments filed November 17, 2009 have been fully considered but they are not persuasive.

**Mayer**

The Advisory Action selectively responds to Applicants' factual and legal arguments in Applicants' Amendment of October 19, 2009. For example, with respect to the primary reference (Mayer), the Examiner has responded to one issue addressed on page 8 of Applicants' Amendment, but omits mention of Applicants' arguments on pages 9-13 of the same Amendment.

First of all, in contrast to Applicants' assertion, the Examiner responded in detail to all major issues addressed on pages 8, **9 and 10** of Applicants' arguments (whether Mayer is directed to a process of **post-OEM refinish** for the repair of damage such as caused by an automobile accident or "fender bender" **or not** on pages 8-9; and **electrostatic spray** on page 10). ***Without resolving the major issues***, the discussion of *minor* issues discussed on pages 11-13 would not add anything important to patentability of claims over Mayer.

**Hartung**

Similarly, with respect to Hartung, the Examiner has responded to one issue addressed in the second paragraph of page 14 of Applicants' Amendment of October 19, 2009, but omits mention of the other arguments in that paragraph or, indeed, the arguments in the first and third paragraphs of page 14 and.

The Examiner stated that Hartung et al was a ***secondary*** reference which was relied upon to show that refinishing could be effected shortly after the original finishing on the production line using a **fresh** coating of basecoat and clearcoat as well as after the automobile has been built (See column 5, lines 62-68). Therefore, all other Applicants' arguments on pages 15-16

Art Unit: 1792

discussing that the secondary reference of Hartung fails to teach all other limitations of claims that are taught by the primary reference of Mayer were absolutely irrelevant to the patentability of claims over Mayer.

### **Other references**

Finally, the Examiner addresses an argument in the last six lines of page 16, but omits mention of Applicants extensive discussion on pages 17-22 of the same Amendment. Thus, Applicants respectfully submit that the rejection is insufficient to support obviousness of the claimed subject matter as a whole.

Without resolving the major issues, the discussion of *minor* issues discussed on pages 17-22 would not add anything important to patentability of claims over Mayer.

### **Current Arguments**

(A) The Advisory Action, on pages 2 and 3, focuses on the issue of whether Mayer teaches a conventional refinish process or a refinish process used in an OEM line. On that issue, the Examiner argues that Applicants argue against their own disclosure, for the reason that the present specification states, in reference to EP 0521 040 B2 (related to Mayer), that a "film-forming coating composition is first applied to the region of the defect in the OEM finish." Applicants respectfully submit that it is quite clear that the present specification refers to EP 0521 040 B2 as "a process for producing a multicoat refinish in the conventional sense. This process constitutes a significant advance in refinish in the conventional sense." [Emphasis added.] Taken out of context, the phrase "defect in the OEM finish" is ambiguous as to whether the defect is (1) an original defect or (2) a later defect. However, since the former interpretation is clearly inconsistent with the plain meaning of the relevant paragraph taken as a whole, one must apply the latter interpretation. Thus, defects in an OEM finish can be interpreted to include, for example, damage from a traffic accident, and it does not follow that the Applicants have stated, or otherwise implied that the refinish in Mayer occurs in an OEM line, contrary to the clear statements otherwise in the relevant paragraph.

First of all, EP 0521 040 B2 is not just related to Mayer, EP 0521 040 B2 is of **the same patent family**, i.e. EP 0521 040 B2 is *equivalent* to Mayer. Second, in contrast to Applicants argument, the phrase "the region of the defect in the OEM finish" carries no ambiguity because the meaning of OEM in the conventional sense has single unambiguous meaning: **Original** Equipment Manufacturer.

Art Unit: 1792

(B) The Examiner has failed to respond to Applicants' arguments that Mayer involves the use of abrasion to bare metal, the use of a "conventional refinish primer surfacer," and the refinishing temperature of 60°C, all clearly applying to conventional refinish and not refinish in an OEM line, as the Examiner argues in the absence of factual support. Applicants further submit that, even assuming *arguendo* that Mayer's process was used in an OEM plant, Mayer does not teach the present process, for the reasons stated on pages 9 to 13 of Applicants' Amendment.

As stated by the Examiner in the Advisory Action, in addition to Applicants own disclosure about EP 0521 040 B2, which is *equivalent* to Mayer, the Examiner stated that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Mayer is applied in combination with Hartung et al that teaches that refinishing can be effected shortly after the original finishing on the production line as well as after the automobile has been built (See column 5, lines 62-68). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have carried out refinishing in Mayer shortly after the original finishing on the production line, as taught by Hartung et al.

Forth, it is irrelevant that Mayer's examples disclose, in the original finish, a basecoat based on cellulose acetobutyrate, as compared to various refinish coatings that do not contain any cellulose acetobutyrate, because damage may occur after the original paint is completely cured in OEM operation, and thus, refinish may be formulated as repair formula, as evidenced by US 20080235224 to Rodrigues et al (See P48, lines 4-8).

(C) For the convenience of the Examiner, Applicants will repeat some of the more relevant points of discussion in Applicants' Amendment: Importantly, Mayer teaches nothing with respect to the original multicoat finish and, therefore, Mayer nowhere mentions electrostatic spray application of the original finish, as required by the present claims. As described in the present application, it was surprisingly found that the multicoat color and/or effect paint systems with which OEM finishes were overcoated no longer exhibited any deleterious shift in shade and/or any deleterious change in optical effect, especially metallic effect, even though the original finish had been produced by means of electrostatic spray application and the refinish was produced by pneumatic spraying. In fact, Mayer teaches a tapering technique that is used to compensate for the fact that the refinish basecoat is, contrary to the present claims, different from the original basecoat. The tapering involves applying the refinish basecoat so that it "tapers off into the adjacent areas," so that "from the edge of the area of damage outwards the film thickness gradually diminishes to 0 gm." Col. 1, line 65, to col. 2, line 1. This technique is used to

Art Unit: 1792

compensate for a change in shade, by gradually blending the different refinish paint shade into the original paint shade .... In any case, the tapering technique of Mayer, with respect to the refinish basecoat, is the critical to Mayer's use of the "aqueous coating material" that goes under the refinish basecoat.

The Examiner respectfully disagrees with this argument. First of all, OEM finish (already) ***produced*** by electrostatic application is a positive limitation of claim 1 not electrostatic application step itself. Second, rephrasing the process limitation with respect to electrostatic spray application might lead to allowable subject matter **only upon showing objective evidence of unexpected results**.

Third, claims do not exclude tapering technique. Mayer teaches expressly that **no shade difference** is noticeable between repair and original finish (See the previous Office Actions).

(D) Applicants state that the present claims exclude the tapering required by Mayer, which eliminates the asserted grounds of the rejection, as pointed out by the Applicants in the above-quoted portion of Applicants' Amendment.

However, in contrast to Applicants' statement, claims **do not exclude** tapering technique.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy Lightfoot whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Friday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/511,080  
Art Unit: 1792

Page 6

Elena Tsoy Lightfoot, Ph.D.  
Primary Examiner  
Art Unit 1792

November 25, 2009

/Elena Tsoy Lightfoot/